



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/556,124

06/22/2006

Roland Wagner

GEB-16347

4356

7609 7590 11/04/2009

RANKIN, HILL & CLARK LLP
23755 Lorain Road - Suite 200
North Olmsted, OH 44070-2224

EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,124	Applicant(s) WAGNER ET AL.	
	Examiner Kuo-Liang Peng	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/28/06 Amendment.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 31 and 32 is/are rejected.
- 7) ☒ Claim(s) 1-28, 31-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' preliminary amendment filed February 6, 2006 is acknowledged. Claims 29-30 are deleted. Claims 1-28 are amended. Claims 31-32 are added. Now, Claims 1-28 and 31-32 are pending.

Claim Objections

2. Claims 1-28 and 31-32 are objected to because of the following informalities:

In Claim 1 (line 4), should "V" be -- V* -- so that it will not be confused with the "V" in formula (V) in Claim 13, and it will be consistent with the "V*" in formulae (I), (II) and (III).

There are additional occurrences of "V" in Claims 1 and other claims, which are advised to be amended accordingly.

In Claim 1 (page 3, last line), should "and" be removed?

In Claim 6 (page 5, line 1), in formula (IV), should "V" be -- V* --?

In Claim 7 (page 5), should the two occurrences of "and" between the formulae be removed?

In Claim 7 (page 6), should the "or" above the line "a tetravalent radical of the formula" be and?

In Claim 13 (page 9, last line), after “-Z³-“, should there be -- ,
respectively --?

In Claim 15 (line 4), before “selected”, should there be -- and --?

In Claim 20 (line 2), should “claims” be removed?

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-28 and 31-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “V^{Si1}” in line 6. There is insufficient antecedent basis for this limitation in the claim.

In Claims 8 (line 4) and 13 (page 8, lines 11-12), “exclusive of the polyorganosiloxane radical” causes confusion because at least one of V (i.e., V*) must contain a polyorganosiloxane radical.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 8 recites the broad recitation “heterocyclic group” (page 6, 2nd line from bottom), and the claim also

recites “ ***preferably*** containing one or more nitrogen atoms, ...” (page 6, last two lines) which is the narrower statement of the range/limitation.

In Claim 8 (page 7, lines 2-6), it is not clear as to what “and wherein the group -NH- bonds tothiocarbonyl carbon atom” refers to.

Claim 11 recites the limitation “V^{si}” in the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation “V^{si}” in the last line. There is insufficient antecedent basis for this limitation in the claim.

In Claim 13 (page 8, line 13 and page 9, line 6), should there be “and” before “-CONR²-“?

In Claim 13 (page 8, line 7 from bottom), it is not clear as to what “-C(O)- and -C(S)-“ refers to.

In Claim 15 (line 2), “consisting of” is inconsistent with “containing” recited in Claim 1.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In Claim 13 (page 9, lines 7-8), Examiner is not able to find the basis for “the groups V^1 and V^2 may be identical or different”.

In Claim 13 (page 9, lines 7-8 and lines 14-15), Examiner is not able to find the basis for V^1 and V^2 containing -C(O)-, -C(S)- and -Z¹.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-28 and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masschelein (US 2002 0103094).

For Claims 1-3, 6-13 and 15-28, Masschelein discloses a polyorganosiloxane composition for treating fabrics, etc., which comprises a cationic silicone polymer containing quaternary nitrogen moieties. The quaternary nitrogen moieties can either present in pendant groups (corresponding to the claimed a2) compound) or in the backbone (corresponding to the claimed a1) compound), and laundry adjunct agents. ([0007]-[0010], [0014], [0039]-[0046], [0164] and Examples) The court stated that "[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize both the cationic silicone polymer containing quaternary nitrogen moieties in the backbone and that containing quaternary nitrogen moieties in the pendant groups with expected success. The amounts of the ingredients are

Art Unit: 1796

exemplified in Examples. For Claims 4-5 and 31-32 Masschelein is silent on the relative amounts of the foregoing cationic silicone polymers.

However, it would have been to one of ordinary skill in the art at the time the invention was made to employ these cationic silicone polymers in an equal amount because both polymers are used for the same purpose in the composition. Especially, Applicants do not show the criticality of the relative amounts thereof. For Claim 14, since Masschelein's composition containing cationic silicone polymers that read on those in the claimed invention, Examiner has reasonable basis to believe both compositions are liquids at 40°C.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1796

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
November 2, 2009

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796